

REMARKS

The Amendment is believed to fully address all and every issue raised in the Office Action mailed November 23, 2009. Favorable reconsideration and allowance of the application are respectfully requested.

Claims Disposition and Summary of Amendments

In the Office Action of November 23, 2009, Claims 1-21 and 23-25 were all the claims pending in the application. Claims 1-13 and 19-21 have been withdrawn from consideration as being directed to non-elected subject matter. Claims 14-19 and 23-35 were considered and rejected.

In the instant application, Applicant amends claim 23 to further define the compound of formula (I-3-4) and to correct a few typographical errors. Formula (I-3-4) is also edited to reflect the current definition of R⁶ and R⁷.

Claims 26-29, directed to a method of treatment using the compound of claim 23, are newly added. As these claims recite all the limitations of claim 23, which are believed to be in condition for allowance, Applicant respectfully submits that these claims should be considered in the instant application.

No new matter is introduced. Entry and consideration of amendment are respectfully requested.

Response to Rejection Under 35 U.S.C. § 112, First Paragraph

In the Office Action, the Examiner maintains the rejection of claims 14-18 and 23-25 under 35 U.S.C. § 112, first paragraph.

The Examiner asserts that Applicants' arguments which refer to the disclosure in the specification of 75 working examples within the scope of claim 23 directed to Formula (I-3-4) were not persuasive. According to the Examiner, claims 14-18 and 23-25 are not enabled, because the compound of Formula (I-3-4) contains numerous heterocyclic rings and various substituents, which may be further substituted, e.g., with additional carbocyclic or heterocyclic rings.

Without conceding the rejection, solely in order to advance the prosecution, Applicant amends claim 23 to further define the scope of formula (I-3-4) to cover only those described in Examples of production and Biological Examples disclosure in the specification. Specifically, the definition of substituents of ring A4, the definition of a ring formed by R⁴ and R⁵, and definition of substituents of ring B are amended. The amended claim 23 is fully enabled by and described in the disclosure of the specification as filed.

Therefore, the above-discussed amendments to claim 23 render the rejection under 35 U.S.C. § 112, first paragraph moot.

Dependent claims 14-21 and 24-25, which directly or indirectly refer to claim 23, also should comply with the 35 U.S.C. § 112, first paragraph requirements.

New Claims 26-29 are patentable

New claims 26-29 each refer, directly or indirectly, to claim 23, which is believed to be in condition for allowance. Therefore, Applicant believes that subject matter of claims 26-29 are patentable over cited references.

Furthermore, as discussed in detail in the Amendment filed August 19, 2009, the specification describes how to make and use the compound of Formula (I-3-4) in treating a mitochondrial benzodiazepine receptor mediated disease in a mammal. Therefore, consideration and allowance of claims 26-29 are respectfully requested.

Response to Provisional Non-statutory Double Patenting

In the Office Action, Claims 23-25, 14-18 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-29 of co-pending Application No. 11/722623 (the '623 application).

In response, Applicant respectfully request the provisional rejection be held in abeyance until the allowable subject matter will be identified in the applications.

Furthermore, as discussed in the above, Applicant believes claims 14-21 and 23-29 of the instant application are allowable. Meanwhile, because the '623 application has a later effective filing date (December 21, 2005) than the instant application (June 22, 2004), withdrawal of the provisional obviousness type double patenting rejection is respectfully requested, should the above claims of the instant application are found allowable.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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